

**REMARKS**

Applicant respectfully requests further examination and reconsideration in view of the amendments above and the comments set forth fully below. By the above amendments, claim 1 is amended. Accordingly, claims 1-12 and 33-34 are currently pending in this application.

**I. Rejection under §§ 102(b).**

In the Office Action, claims 1-12 are rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,093,237 to Weiss (hereinafter “Weiss”). The Applicant respectfully traverses this rejection because Weiss does not teach a seventh game piece designated by a seventh type (as claimed in the independent claim 1), and Weiss does not teach that each one of the first game pieces is configured to be specifically aligned with each of the other first game pieces (as claimed in the independent claim 7).

The present invention is directed to a game board that is divided into an inner play area and an outer play area. The inner play area is divided into quadrants. The playing pieces include at least seven different types. The first type is referred to as “Human Beings”, the second through fifth types are four different types of trees, the sixth type is referred to as “forest spirits”, and the seventh type is referred to as an “Opportunity token.” By the above amendments to claim 1, the plurality of game pieces include “a seventh game piece designated by a seventh type.”

Weiss teaches a modified chess game including a game board divided into four quadrants, each quadrant represented by a unique color. The modified chess game is played with four sets of 16 conventional chess pieces. Each set includes a king, a queen, two bishops, two knights, two rooks, and eight pawns. Each set of game pieces is a unique color which corresponds to one of the quadrant colors. As such, the first set of chess pieces, including a first queen, a first king, a first two bishops, a first two knights, a first two rooks, and a first eight pawns, are each of a first color, for example blue. Similarly, each of the second set of chess pieces is a second color, for example red, each of the third

set of chess pieces is a third color, for example purple, and each of the fourth set of chess pieces is a fourth color, for example green. Weiss does not teach a seventh game piece designated by a seventh type.

For at least these reasons, the Applicant respectfully submits that Weiss does not anticipate claim 1. Since claims 2-6 are dependent upon claim 1, Applicant respectfully submits that Weiss does not anticipate claims 2-6 for at least the reasons discussed above.

The independent claim 7 includes the limitation “a plurality of first game pieces designated by a first type, wherein each one of the first game pieces is configured to be specifically aligned with each of the other first game pieces” (emphasis added). Weiss teaches game pieces configured as a kings, queens, bishops, knights, rooks, and pawns. There is no hint, teaching, or suggestion within Weiss that any of the types of pieces are configured to be specifically aligned with each other.

Within the Office Action, the Examiner argues that game piece shapes are configured according to personal preferences that are aesthetically pleasing. The Examiner concludes that one of ordinary skill in the art would have suggested configuring specific shapes for game pieces to attract potential players. The Applicant respectfully disagrees with this conclusion.

The specific shapes of each of the first game pieces are claimed in the dependent claim 34. However, the specific shape of each first game piece is not due to aesthetics. As claimed in the independent claim 7, “each one of the first game pieces is configured to be specifically aligned with each of the other first game pieces.” The shape of each of the first game pieces goes directly to alignment, not merely as an eye-pleasing design choice. Alignment goes to the function of each of the plurality of first game pieces. The physical characteristics by which the first game pieces are configured determine how each first game piece is aligned relative to each other (see Specification, Figures 12-14). By definition, such configurations of the first game pieces are functional limitations, not rules or methods of play that define how each of the first game pieces are played.

According to MPEP 2173.05(g), “[a] functional limitation is an attempt to define something by

what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms...A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.”

Clearly, a configuration of a playing piece to determine it's alignment with other playing pieces is a functional limitation as defined in the MPEP. As such, the claimed limitation “each one of the first game pieces is configured to be specifically aligned with each of the other first game pieces,” should be considered as a limitation of the independent claim 7. As described above, Weiss does not teach such a limitation.

For at least theses reasons, the Applicant respectfully submits that Weiss does not anticipate claim 7. Since claims 8-12 are dependent upon claim 7, the Applicant respectfully submits that Weiss does not anticipate claims 8-12 for at least the reasons discussed above. In view of the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the §102(b) rejection of claims 1-12.

## **II. Rejection under §§ 103(a)**

In the Office Action, claims 33 and 34 are rejected as being unpatentable over Weiss. Claim 33 is dependent on the independent claim 1. Claim 34 is dependent on the independent claim 7. As discussed above, the independent claims 1 and 7 are allowable over Weiss. As such, each of the dependent claims 33 and 34 are also allowable as being dependent upon an allowable base claim.

CONCLUSION

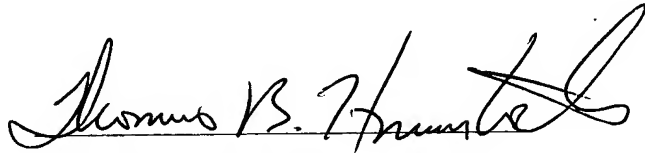
In view of the foregoing, the Applicant respectfully submits that all claims, namely claims 1-12 and 33-34, are in condition for allowance. Reconsideration of the rejections is requested. Allowance is earnestly solicited at the earliest possible date. The Examiner is encouraged to call the undersigned at (408) 530-9700, with questions or comments so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

Dated: 3-21-07

By:



Thomas B. Haverstock

Reg. No.: 32,571

Attorneys for Applicant